

Japanese Patent 6-64076, for the reasons set forth in the sub-paragraphs 2, 3 and 4.

Please note that there is a feature distinguishing this invention from the prior art which was full surprising for the inventor, namely that the glass fibers should of non-twisted nature. This fact is also very useful as regards the prior art being applied by the Examiner.

Furthermore, the examiner clearly admits that EP '795 fails to teach the specific amount of resin in the reinforcement. The specific amount of resin is an essential feature of the invention; this feature was always included in the claims as originally filed.

The examiner then refers to Japanese '852 to indicate what an ordinary artisan knows and understands. Applicant has had a translation of part of Japanese Patent '852 prepared, and a copy enclosed. Please note specifically pages 2 and 3 wherein it is stated that the reinforcing of thin slabs of natural stone by means of FRP layer containing chipped strand is not satisfactory and for this reason in this prior reference recourse is made to a rather complex reinforcing structure consisting of multiple layers.

Consequently even with the prior art cited by the Examiner, it is demonstrated that the use of non-twisted glass fibers by which the problem encountered is solved was fully unexpected in view of the common knowledge in the related art.

Note that while Claim 1 calls for a slab of stone material having a rear substantially smooth face, Claim 12 also has the same limitation, it is only when Claims 1 and 28 are compared that there is a divergence because two different

embodiments are being protected. The summary of the invention as set forth at the bottom of column 2 of the patent in lines 60 to 67 makes no mention of grooves or recesses. In fact, a further description of the invention in column 3 wherein the preferred embodiments are discussed, the various ancillary features pertinent to the invention, and then in line 34 (column 3) grooves are mentioned for the rear surface but as a relationship to the prior art, and it is for this purpose it adds a prior art feature having a unique relationship with the novel and inventive features claimed in Claim 21. Claim 29 was added to further amplify this feature.

The Japanese '852 patent is primarily intended to provide strength and bendability. This is not the purpose of applicant's invention. In fact, the '852 patent teaches away from the teaching of applicant's invention. Therefore, no modification of EP'795 with the Japanese '852 comes even close to the teachings of applicant's claimed invention.

With respect to Japanese '076, it is the examiner's belief that one skilled in the art would have applied the longitudinal, non-twisted reinforcement against the stone panel, the examiner's belief or conjecture is not sufficient. Applicant has a claim which is restricted to the features set forth in the claim. The examiner is making a piece-meal selection of isolated features from a number of different patents, and when combining these features, the examiner still opines that one skilled in the art would add features not disclosed, nor suggested, not taught in the prior art, regardless how the disclosure of the patents cited references are expanded.

At this juncture, it is proposed to deal with the matter of the rejection of Claims 21-38 under 35 U.S.C.251 as being an improper recapture of subject matter alleged to have been surrendered in the parent application.

At the outset, it should be noted that none of the prior art of record teaches disposing a reinforcing layer between the linear reinforcing elements and the rear face of the slab of stone material. This is the reason the order of the Examiner's rejections was not followed.

Claim 1 included a clause which provides that the rear face of the stone material was substantially smooth and free from grooves or recesses, but it was never added to distinguish from the prior art, as will be explained.

Claim 21 in the Reissue application omits - free from grooves or recess--, and claim 1 as allowed included this recitation, but it is not and was not a feature for which the examiner indicated reasons for allowance was argued and the examiner clearly recognized this because if the notice of allowance of February 19, 1997 is considered and carefully analyzed, it will be noted that the statement "--where rear face of the stone material was substantially smooth and free from grooves or recess--" was contained within parenthesis and therefore could just as well have been omitted from the reasons for allowability because terms within parenthesis can be omitted without changing the meaning of the clause or statement. Moreover, the reasons for allowability are carefully set forth by the examiner as follows;

--None of the prior art of record teaches disposing a reinforcing layer between the linear reinforcing elements and the rear face of the slab of stone material (material in parenthesis omitted).

Since applicant and then applicant's attorney interpreted the reasons for allowability as excluding extraneous material in parenthesis, there was no reason to contest the examiner's statement.

The examiner's statement justifies the limitations in the clause for allowability and patentability purposes when claim 1 is read, and considering the prior art as applied.

Now, it is necessary to consider new claim 21 and the claims dependant thereon which were submitted in the Reissue application. The reasons for allowability apply to claim 21 as well. There is no mention of the statement which appears in parenthesis in reasons for allowance.

Reference is made to Webster's Third New International Dictionary, Page 1641, (page copy enclosed) which provides the following definition of --parenthesis-

-:

1a: An amplifying or explanatory comment inserted in a passage to which it may be grammatically unrelated and from which it is usually set off by punctuation (as curved lines, commas or dashes....

1b: A remark or passage that constitutes a departure from the theme of the discourse: Digression

2: ...

3a: .....----compare BRACKET 4a

Note also the meaning of "parenthesize"

1: to make a parenthesis of " to interject as comment or digression

2: ...something in parenthesis.

The examiner's main point is that applicant is trying to recapture subject matter which was surrendered in the patented file and such is not a proper reissue application. Clearly, applicant respectfully dissents.

In the originally filed application two problems were contemplated. Please note, it was clearly stated that the inventor was facing two specific situations, namely those in which the strength of a thin slab of natural stone (marble or granite for instance) had to be increased enough to permit the use thereof to overcome the intrinsic fragility due to the too high thinness, and those in which the final slab was to be used in cases of heavy duty, such as for instance for suspended floorings or outer wall coverings.

In the first case, according to the invention the rear face of the slab is provided with the reinforcing layer of non-twisted linear glass fibers impregnated with a hardenable resin.

In the second case, the rear face of the slab is reinforced according to the cited prior art by means of grooves provided in the rear face and housing the reinforcing elements and preferably a hardenable resin, and then the reinforcing layer according to the present invention is added.

In this particular case, and with specific reference to the original patent, no mention is made in claim 1 of grooves or recesses, and then claim 8 adds the formation of grooves or recesses on the rear face of the slab, and the reinforcing elements are housed in the grooves or recesses.

The reasons for allowability takes this into consideration, because if the material in parenthesis is or was essential, then the examiner would not have allowed claim 1 without the limitations of claim 8. Further, the examiner also would not have allowed claim 9 which incorporates all of the limitations of claims 1, 8 and 9.

Then the examiner must consider his own decision with respect to claims 9 to 13, which specifically restrict claim 1. If the statement or clause "free from grooves or recesses" is an essential feature or limitation of the claim as the examiner contends, then claims 8 to 13 would not have been considered. But, since they were considered, then the material in parenthesis was not the "reason

for allowability”, and since the original statement without the material in parenthesis was satisfactory, there was no need for applicant to contest or modify what the examiner stated.

In the original prosecution of the parent application claim 9 was specifically amended to add the grooves and recesses.

For claim 1 of the parent application, original claim 7 was added to claim 1 during prosecution of the original or basic application; and, this is the limitation to which the examiner referred in the reasons for allowance.

The second limitation added was the “hardening of its resin”, and this limitation is also contained in claim 21 added in the Reissue application.

Now, comparing claim 1 and claim 21, the first feature in claim 1 includes: “free of grooves or recess”, and claim 21 makes no mention of grooves or recesses.

The examiner is also taking the comment about the rear face of a slab of stone material out of context. Specifically this comment refers to the first sentence in this paragraph which refers to the amendment of claim 1 to distinguish from natural stone as well as products made of stone material. Claim 1 was not amended to set forth as the examiner contends that the rear face of a slab of stone material which --is free of grooves or recesses. (emphasis added). The word “this” refers to the amendment of claim 1 in line 2 --products made of --.

It is the contention of the applicant that claim 21 was not broadened out to arrive at claim 1. A careful analysis of claim 21, clearly indicates that this claim included a narrowing limitation over claim 1. Specifically claim 1 calls for providing non-twisted linear reinforcing elements.

And, it is not until claim 8, that the linear reinforcing elements are placed or housed in the grooves or recesses.

Now, considering claim 21 and the reinforcing rear elements are applied to the rear face. Therefore, new claim 21 is narrower than claim 1 in some respects, and almost as narrow as claim 8. Claim 1 does not specifically place the reinforcing elements on the rear face, and therefore claim 1, is broader than claim 21 in this respect. The examiner is not giving any weight to this clear distinction.

The examiner has also taken issue with the omission of the limitation relating to the inclusion of a reinforcing layer between the coated non-twisted linear reinforcing elements and the rear face of the stone material. While the examiner indicates that this feature was strenuously argued, applicant respectfully dissents from the examiner's conclusion or attribution. Moreover, assuming *arguendo* that the examiner is correct, this argument did not appear to impress the examiner because the examiner did not see fit to include this argument in the reasons for allowability. And, applicant did not ask for a modification of the reasons for allowability to include this feature.



In the "original application" evidences were given in the form of the data relating to the mechanical properties of the reinforced slabs with respect to the first mentioned embodiment, because the dramatic increase of these properties (flexural strength and impact strength) lacking any other reinforcing provision was considered the best demonstration that an invention had been made. Of course in the case of the other (namely "heavy duty") embodiment was considered unnecessary.

The Applicant has never indicated his willingness to abandon either of the above-mentioned embodiments.

In the allowed main claim - claim 1, the sentence or limitation "inserting a reinforcing layer between the coated non twisted linear reinforcing elements and the rear face of the slab of stone material" would be a non sense since in the case of the first mentioned embodiment nothing is being inserted between the rear face of the slab and the reinforcing layer consists only of non twisted glass fibers and hardenable resin, and would be contradictory in the case of the "heavy duty" embodiment since the preamble of the claim would exclude any case in which the rear surface of the slab is not smooth and free from grooves and recesses, but in this case the reinforcing layer being inserted would be (as taught in the specification) that consisting of grooves containing linear reinforcing elements and possibly resin.

As a matter of fact this situation is clearly faced by the wording of claim 21.

The examiner has noted page 7 of the response dated December 23, 1996 and applicant's argument over Toncelli '015. This is a description of applicant's own prior art and applicant's further distinction over his own prior art. It is the inclusion of the subject matter of a former claim 7 into claim 1, and claim 7 (cancelled after claim 1, was amended) referred to the insertion of this metal reinforcing elements between the reinforcement and the rear face of the slab. Note claim 7 was originally appendant to claim 5, but the claim 5 limitation was never added to claim 1.

It appears to be the examiner's position that because the language the examiner selected to allow the original application is the reason that applicant should be denied the Reissue claims. However this is not what the Reissue Statute requires

Reference is made to Bionx Implants Inc. v. Biomet Inc. 54 USPQ 2d 1076. This case holds that a "claim that is narrower in scope than the original application escapes the recapture rule entirely. In this case, an express limitation in the reissue claim was omitted. Specifically, the claim and application were concerned with an express limitation (which was omitted) that starting material for screw be in nonfibular state, since original patent does not claim that starting polymer must be nonfibular in its entirety, and since reexamined patent is narrower than original, in that it limits specific type of claimed device to screw.

Reference is also made to Ball Corp. v. United States 799 F. 2d 1429, 1436 [221 USPQ 289] (Federal Express delivery. Cir 1984) which held that a reissue

claim what is narrower in scope than the original application escapes the recapture rule entirely.

In applying the recapture rule of 35 U.S.C. ¶251, the examiner should (determine) consider the following:

(1) whether and in what aspect the reissue claims are broader than the original patent claims;

(2) whether the broader aspects of the reissued claims relate to surrendered subject matter; and

(3) whether the broader claims are an attempt to recapture impermissibly, limitations that were surrendered in order to overcome prior art rejections.

In all aspects the reissue claims are free from the above-noted defects or objections.

Reference is also made to United States Fuller Corp. v. Ionics, Inc. 53 USPQ 2d 1072, which also sets forth the required steps in applying the "recapture rule" of 35 U.S.C. ¶251.

In this case, the substitution of word "secured" in claims of reissue patent for word "bonded" did not violate the recapture rule even though "secured" is broader

then "bonded" since no changes made in application for original patent to overcome prior art involved the word "bonded" since no changes [were] made in application for original patent to overcome prior art involved word "bonded", and therefore nothing surrendered during prosecution of that patent relates to "bonded" and since changes from "bonded" to "secured" thus cannot be impermissible recapture.

Basically, the "recapture rule" prevents a patentee from regaining through reissue the subject matter surrendered during the prosecution of the original patent in an effort to obtain allowance of that original patent.

The only change that the examiner disputes is -- free from grooves or recesses -- see last line on page 2 of the Office Action, but this was not specifically added to claim 1, and the examiner in his reasons for allowability does not include this as an essential limitation. If applicant is wrong then the attorney did not understand the Examiner, and the Examiner should not have used a qualifier which can be omitted.

Furthermore, no substantive changes were made in the original claims (in the reissue as filed) 1 to 20 so as to have them issued in the reissue application.

It should be noted that an important feature in common with the claims of the original patent and the Reissue claims is that there is a layer of non-twisted glass reinforcing elements. This was argued and pointed out in the specification.

Reference is made to the citation of Hester Industries, Inc. v. Stein 46USPQ 2d 1641 (hereinafter "Hester"), and clearly while this case does indicate that the grant of reissue claims that are broader than original claims, it also indicates that this pertains to the surrender of subject matter during the prosecution of the application. Further, with respect to Hester, this case held that the reissue claims which are broader in certain respects than the claims of the original patent had not been materially narrowed in other respects so as to avoid the operation of "recapture rule". In this regard, applicants specifically wish to point out that while the claims, specifically claim 21 may have been broadened according to the Examiner in one respect, it has been narrowed in another respect, and the narrowing in the other respect was never clearly given up during prosecution of the parent or original patent. Note that applicant at all times does not consider the omission of the words in parentheses to be a broadening. And, as noted in the reasons for allowability, the portion of the claim referred to by the examiner and not excluded from claim 21 by making reference to parenthesis is still in new claim 21. All that was omitted was the material in parentheses which the examiner clearly indicates is not part of the reasons for allowance

Clearly, the situation of the present application differs from Hester because if the examiner is correct, then the undersigned attorney did not appreciate the full scope of the invention during the prosecution of the original patent application, and further, applicant's attorney was then misled by the examiner's statement regarding allowability because no other reason for allowance was included in such statement. And the reasons for allowability would also pertain to the claims

presented in the reissue application for the first time. Limitations are not being removed, but a different aspect of the invention is being claimed. Perhaps what the examiner may consider a broadening is really a claim directed to perhaps a different invention. If a different invention is the examiner's position, then the examiner should require a division. In Hester, which is different from the present application, the claims are broader, but not narrower, in the present case the claims are broader in some respects, but extremely narrow in other respects. Looking at the prosecution history, as noted above, it is clear that the material does not relate to surrendered subject matter.

Hester clearly sets forth that the applicant in that case repeatedly argued during prosecution of the original patent that certain limitations distinguish the original claim for prior art and that each of these limitations was critical to patentability, and since these repeat arguments constitute admissions by applicant, additional limitations were necessary to overcome the prior art. Clearly, in the present case, no such arguments were made. Explanations were made but no arguments were made to support a limitation which is necessary in any of the claims 21-38 of the reissue application.

This case, the Hester Industries case, on page 1648 refers to *In re Weiler, et al.* 229USPQ 675 to indicate that the reissue statute is based on fundamental principles of equity and fairness and should be liberally construed. Clearly, the applicant in the present application did not give up anything, the applicant just did not claim the invention all the different ways he was able to claim it. The application

SN 08/513,687, now U.S. Patent No. 5,670,007 also did claim the invention all the different ways the invention could be claimed.

With respect to *In re Clement* 45USPQ 2d 1161 (Fed. Cir. 1997) it should be noted that this case held that the recapture rule applies to reissue claim to prevent obtaining such a claim, if it is as broad as or broader than a canceled or amended claim in all respects; note the term "all". If the reissue claim is narrower in all respects the recapture rule does not apply, but other rejections are possible. Clearly, if there is an aspect in which the Reissue claim is narrower, then the reissue claim is not broader in all (emphasis added) respects. In the present situation, it is respectfully submitted that the recapture rule does apply because the new reissue claims 21-38 are not broader in all respects than any previous claim on file during the prosecution of the original parent application. Recapture rule does not apply if claim is broader in respect of a matter non-canceled during prosecution.

Claims 8-13 and 26-38 were again rejected under 35 U.S.C. 103(a) for the same reasons as set forth in the previous official action in paragraph 6 and the examiner uses the same patent EP '015 in view of Japanese '076, Japanese '852 and EP '795, with the exception that in this official action, the examiner restricted rejection to Claim 8-13 and not 1-20, while Claims 26-38 were referred to in both official actions. Perhaps, the rejection in the final action should have been bifurcated, if paragraph 6 of this action is to follow paragraph of the previous official action.

Specifically, the rejection can not apply to Claims 26 and 27 because these claims do not include the limitation of groove or recesses, and only claims 28 and 29 refer to grooves or recesses. Therefore, EP '015 is to be removed from the rejection as a basic reference. With respect to Japanese '076, and considering this patent with respect to Claims 28 and 29, and Claims 8-13 of the original patent.

The basic patent EP '015 is Tonicelli's own patent, and the present invention is an improvement thereover. In effect what the examiner is saying is that prior to June 25, 1993, Mr. Tonicelli should have been aware that it was obvious to what is claimed in Claims 8-13 and 26-38. However, the '015 patent did not satisfy the requirement and the specification in the preamble takes us into consideration if the examiner will consider column 2 lines 37 - 44. Note, line 52-57 and the material contained therein. If the examiner would like to have a declaration from Mr. Tonicelli, who is the inventor of the particular patent cited as well as this application, to substantiate the statements made in this patent, this can be provided. However, the mere fact that Mr. Tonicelli signed the original patent documents attests to the validity and proof of this statement made. Therefore, even with Claim 28 and 29 and 8-13, this patent should be removed as a basic patent. With removal of the basic patent, there is no suggestion or teaching in any of the other prior art how applicants earlier patent can be modified.

Further, Claims 8-13 were allowed in the original patent, and the basic patent cited by the examiner EP '015 was available as prior art in the earlier patent and was submitted in the information disclosure statement.

Therefore, all of the claims now in the application are clearly and patentably distinguished from all the references cited by the examiner taken either singular or



combined in any valid combination. Also, there is no motivation in any of the references cited by the examiner or brought to the attention by the applicant as to any motivation as to how these can be combined.

With respect to the question of the broadening reissue, it is further submitted that there was no broadening reissue but the reissue is broadened in some respects but narrow in other respects as clearly indicated in the argument.

In view of the foregoing, early and favorable reconsideration is respectfully solicited.

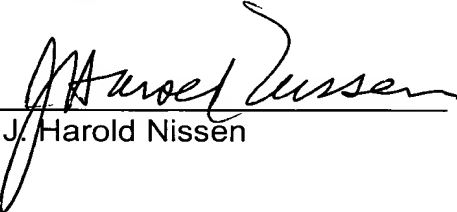
A separate request for an extension of time has been submitted. If for some reason it becomes detached, please use this as your authorization to obtain a three month term extension and charge this to deposit order account at 50-1529.

Early and favorable reconsideration is respectfully solicited.

Respectfully submitted,

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